

REMARKS

Supplemental to the Amendment filed on January 21, 2009, this is in further response to the Office Action of September 17, 2008. Applicants again gratefully acknowledge the Examiner's indication that this application is drawn to patentable subject matter. Claim 1 is amended to delete an unnecessary formula. Claims 35-41 are amended, without prejudice, to delete the recitation of "preventing" diseases or disorders. No new matter is introduced by this Amendment. Claims 1-46 remain pending in the application.

Rejoinder requested – method of making

This application is the U.S. national phase of a PCT application. Accordingly, 'unity of invention' rules apply. 37 CFR 1.475(b)(3) provides that unity of invention exists if the claims are drawn to the combination: "A product, a process specially adapted for the manufacture of the said product, and a use of the said product." MPEP 1893.03(d) provides that any non-elected process of making an allowable product should be considered for rejoinder, following the practice set forth in MPEP 821.04(b). Accordingly, since process claims 33 and 34 are drawn to processes of making the claim 1 compounds, rejoinder of claims 33 and 34 with allowable claim 1 is earnestly solicited. During a telephonic discussion with Applicants' representative, Richard Gallagher, on February 23, 2009, Examiner Moore acknowledged that the requested rejoinder is in conformance with the policy set forth in the MPEP.

Rejoinder requested – method of using

This application is the U.S. national phase of a PCT application, so that 'unity of invention' rules apply. 37 CFR 1.475(b)(3) provides that unity of invention exists if the claims are drawn to the combination: "A product, a process specially adapted for the manufacture of the said product, and a use of the said product." MPEP 1893.03(d) provides that any non-elected process of using an allowable product should be considered for rejoinder, following the practice set forth in MPEP 821.04(b). Accordingly, since method of use claims 35-45 are drawn to methods of using the claim 1 compounds, rejoinder of claims 35-45 with allowable claim 1 is earnestly solicited. It is pointed out that claims 35-41 have been amended to recite methods of

treating diseases or disorders and that claims 42-45 relate respectively to methods for the induction of sedation-hypnosis, anesthesia, sleep, and muscle relaxation. During a telephonic discussion with Applicants' representative, Richard Gallagher, on February 23, 2009, Examiner Moore acknowledged that rejoinder is in conformance with the policy set forth in the MPEP.

Rejection under the second paragraph of 35 U.S.C. § 112

Claims 1, 2, 4, 5, 7, 8, 10, 12, 14, 16, 18, 20, 22, 23, 25, and 46 were rejected under the second paragraph of 35 U.S.C. § 112. Office Action of February 12, 2008, page 3, top. As suggested in the Office Action, claim 1 is amended to delete an unnecessary formula. Due to the amendment of claim 1, it is respectfully submitted that each of claims 1, 2, 4, 5, 7, 8, 10, 12, 14, 16, 18, 20, 22, 23, 25, and 46 in its present form satisfies the requirements of the statute.

Contact information

The Examiner is respectfully requested to contact Richard Gallagher, Registration No. 28,781, at (703) 205-8008 with any questions concerning this application.

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Respectfully submitted,

By

Marc S. Weiner

Registration No.: 32,181

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Falls Church, Virginia

(703) 205-8000

Attorney for Applicant